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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,139	11/21/2001	Yukio Nishikawa	YMOR:229	9445
7590	03/17/2004			
PARKHURST & WENDEL, L.L.P. Suite 210 1421 Prince Street Alexandria, VA 22314-2805				
EXAMINER LAVILLA, MICHAEL E				
ART UNIT		PAPER NUMBER		
1775				

DATE MAILED: 03/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,139

Applicant(s)

NISHIKAWA ET AL.

Examiner

Michael La Villa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2-9 and 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 10, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 11 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 20040305.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:
2. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is unclear where the original disclosure teaches an alumina anticorrosive coating layer lacking elemental magnesium in the claimed context of proposed Claim 1. Applicant's citation to page 17 teaches an anticorrosive layer. However, it is unclear where the disclosure at page 17 is as broad as claimed in Claim 1. The alumina layer at page 17 appears in the context of a specific bi-layer having other properties that have not been claimed. Specific support for each claimed limitation in combination with the other claimed features is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
5. A person shall be entitled to a patent unless –

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6. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
7. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Fukumura et al. WO00/40777. Fukumura teaches coating magnesium molded bodies with an organic acid amine salt and further coated with a paint layer. See English language equivalent Fukumura USP 6,569,264 (Abstract; col. 3, lines 4-24; col. 7, lines 6-14; col. 8, lines 48-64; col. 9, lines 53-62; col. 10, lines 21-54; col. 11, line 60 through col. 12, line 50; col. 13, line 27 through col. 14, line 35; col. 16, lines 5-45; and claim 1). Fukumura does not teach a cut portion, but the pretreatment process of Fukumura would be expected to provide a clean magnesium surface that is indistinguishable from one that had been cut and exposed. The corrosion prevention layer of Fukumura would be expected to be transparent since Fukumura characterizes the magnesium surface quality which would only be possible if the coating were transparent. Fukumura does not directly state that the paint layer is transparent, but it would be expected to be at least partially transparent in order to provide a coated article that exhibits a magnesium metal surface quality, the goal of the invention of Fukumura.
8. Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Fukumura et al. USP 6,569,264. Fukumura teaches coating magnesium molded bodies with an organic acid amine salt and further coated with a paint layer. See Fukumura (Abstract; col. 3, lines 4-24; col. 7, lines 6-14; col. 8, lines 48-64; col. 9, lines 53-62; col. 10, lines 21-54; col. 11, line 60 through col. 12, line 50; col. 13, line 27 through col. 14, line 35; col. 16, lines 5-45; and claim 1). Fukumura does not

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teach a cut portion, but the pretreatment process of Fukumura would be expected to provide a clean magnesium surface that is indistinguishable from one that had been cut and exposed. The corrosion prevention layer of Fukumura would be expected to be transparent since Fukumura characterizes the magnesium surface quality which would only be possible if the coating were transparent. Fukumura does not directly state that the paint layer is transparent, but it would be expected to be at least partially transparent in order to provide a coated article that exhibits a magnesium metal surface quality, the goal of the invention of Fukumura.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 10, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukumura et al. WO00/40777. Fukumura teaches coating magnesium molded bodies with an organic acid amine salt and further coated with a paint layer. See English language equivalent Fukumura USP 6,569,264 (Abstract; col. 3, lines 4-24; col. 7, lines 6-14; col. 8, lines 48-64; col. 9, lines 53-62; col. 10, lines 21-54; col. 11, line 60 through col. 12, line 50; col. 13, line 27 through col. 14, line 35; col. 16, lines 5-45; and claim 1). Fukumura does not teach a cut portion, but the pretreatment process of Fukumura would be expected to provide a clean magnesium surface that is indistinguishable from one that had been cut and exposed. The corrosion prevention layer of Fukumura would be expected to be transparent since Fukumura characterizes the magnesium surface quality which would only be possible if the coating were transparent. In the event that the paint layer is not transparent, it would have been obvious to one of ordinary skill in the art at the time of the invention to formulate a transparent paint layer in order to provide a coated article that exhibits a magnesium metal surface quality, the goal of the invention of Fukumura. Fukumura does not exemplify audio apparatus casings, but teaches that magnesium molded bodies are effective for audio apparatus components. It would have been obvious to one of ordinary skill in the art at the time of the invention to fabricate audio apparatus components, which would include casing components, since Fukumura teaches that the materials of Fukumura are effective for this purpose.

12. Claims 10, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukumura et al. USP 6,569,264. Fukumura teaches coating magnesium molded bodies with an organic acid amine salt and further coated with a paint layer. See Fukumura (Abstract; col. 3, lines 4-24; col. 7, lines 6-14; col. 8, lines 48-64; col. 9, lines 53-62; col. 10, lines 21-54; col. 11, line 60 through col. 12, line 50; col. 13, line 27 through col. 14, line 35; col. 16, lines 5-45; and claim 1). Fukumura does not teach a cut portion, but the pretreatment process of Fukumura would be expected to provide a clean magnesium surface that is indistinguishable from one that had been cut and exposed. The corrosion prevention layer of Fukumura would be expected to be transparent since Fukumura characterizes the magnesium surface quality which would only be possible if the coating were transparent. In the event that the paint layer is not transparent, it would have been obvious to one of ordinary skill in the art at the time of the invention to formulate a transparent paint layer in order to provide a coated article that exhibits a magnesium metal surface quality, the goal of the invention of Fukumura. Fukumura does not exemplify audio apparatus casings, but teaches that magnesium molded bodies are effective for audio apparatus components. It would have been obvious to one of ordinary skill in the art at the time of the invention to fabricate audio apparatus components, which would include casing components, since Fukumura teaches that the materials of Fukumura are effective for this purpose.

Allowable Subject Matter

13. Claims 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The reasons for allowability of these claims have been addressed previously in the Office Action mailed on 9 April 2003.

Response to Amendment

- I. In view of applicant's amendments and arguments, applicant has traversed the section 112, second paragraph rejection of the Office Action mailed on 9 April 2003. Rejection is withdrawn.
- II. In view of applicant's amendments and arguments, applicant has traversed the section 102 and 103 rejections over Schmeling of the Office Action mailed on 9 April 2003. Rejections are withdrawn.
- III. In view of applicant's amendments and arguments, applicant has traversed the section 103 rejection over Seki of the Office Action mailed on 9 April 2003. Rejection is withdrawn.
- IV. In view of applicant's amendments and arguments, applicant has traversed the section 103 rejection over Baer of the Office Action mailed on 9 April 2003. Rejection is withdrawn.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.
15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.
16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael La Villa
March 5, 2004

